

REMARKS

This amendment is in response to the Office Action of July 29, 2005.

Claims 1 through 20 are currently pending in the application.

Claims 1, 3, 4, 12, 14 through 16, and 18 through 20 have been amended herein. All amendments are made without prejudice or disclaimer. No new matter has been added to the disclosure which complies with the provisions of 35 U.S.C. § 132. Support for the amendments may be found in paragraphs [0009] and [0025] of the specification.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on Hibino (U.S. Patent 5,694,618)

Claims 4, 5, 7, 9, 12 through 15, and 17 through 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hibino (U.S. Patent 5,694,618). Applicant respectfully traverses this rejection.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 4, as amended, is directed to a method for saving and restoring printer control settings, comprising . . . executing a printer control program for creating and saving printer control settings; using the printer control program to select at least one printer associated with the printer control program; retrieving available control settings for the at least one selected printer; displaying the retrieved available control settings for selection by a user; selecting desired control settings from the retrieved available control settings; permanently saving the selected desired control settings for later retrieval; and updating the at least one selected printer with the desired control settings.

Applicant asserts that Hibino does not identically describe, either expressly or inherently, the elements of the claimed invention of presently amended independent claim 4 to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Hibino does not identically describe the elements of the claimed invention calling for “saving said selected desired control settings for later retrieval.” Applicant asserts that, at best, Hibino describes an

approach for changing the settings of a printer when bi-directional transmission, via a Centronics interface, between a computer and a printer is not possible. *See, Abstract and Column 6, lines 5-18.* Hibino describes that by operating the keyboard or the mouse, the user can change the settings of the printer. Column 4, lines 63-65. Settings changed by the operator are outputted to the printer and the printer sets its operating environment accordingly. Column 4, lines 65-67. However, Applicant asserts that Hibino does not describe saving the changes to the printer settings for later retrieval. Applicant asserts that it is inherent in Hibino that the changes are not saved, but the changes must be re-entered every time data is sent to the printer for printing. Therefore, Hibino does not describe the element of the presently claimed invention calling for “saving said selected desired control settings for later retrieval.” Therefore, claim 4 is not anticipated under 35 U.S.C. § 102. Accordingly, presently amended independent claim 4 is allowable.

Claims 5, 7, and 9 are allowable as depending from allowable presently amended independent claim 4.

Claim 12, as amended, is directed to a document production system for setting and maintaining printer control settings, comprising . . . at least one printer for printing documents conforming to stored control settings stored in a memory of the at least one printer; and a printer control program for retrieving control settings from the at least one printer, saving customized control settings for later use, downloading customized control settings, and updating stored control settings in the memory of the at least one printer with the customized control settings.

Applicant asserts that Hibino does not identically describe, either expressly or inherently, the elements of the claimed invention of presently amended independent claim 12 to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Hibino does not describe expressly or inherently the elements of the claimed invention calling for “saving customized control settings for later use.” Applicant asserts that, at best, Hibino describes an approach for changing the settings of a printer when bi-directional transmission, via a Centronics interface, between a computer and a printer is not possible. *See, Abstract and Column 6, lines 5-18.* Hibino describes that by operating the keyboard or the mouse, the user can change the settings of the printer. Column 4, lines 63-65. Settings changed by the operator are outputted to the printer and the printer sets its operating environment

accordingly. Column 4, lines 65-67. However, Applicant asserts that Hibino does not describe saving the changes to the printer settings for later retrieval. Applicant asserts that it is inherent in Hibino that the changes are not saved, but the changes must be re-entered every time data is sent to the printer for printing. Therefore, Hibino does not describe the element of the presently claimed invention calling for “saving said selected desired control settings for later retrieval.” Therefore, claim 12 is not anticipated under 35 U.S.C. § 102. Accordingly, presently amended independent claim 12 is allowable.

Claims 13 through 15 and 17 through 19 are allowable as depending for allowable presently amended independent claim 12.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Kimber et al. (U.S. Patent 5,371,837) in view of Bryant et al. (U.S. Patent 4,846,597)

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimber *et al.* (U.S. Patent 5,371,837) (“Kimber”) in view of Bryant *et al.* (U.S. Patent 4,846,597) (“Bryant”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure.

Claim 1, as amended, recites a method for saving and restoring printer control settings, comprising . . . selecting control settings for a printer using a control panel graphic user interface of the printer; executing a printer control program for determining the selected control settings for the printer; and saving the selected control settings to a media storage device.

Applicant asserts that Kimber and Bryant, even if combinable, do not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed

invention of presently amended independent claim 11 because any combination of such prior art fails to teach or suggest all the claim limitations of the claimed invention. Applicant asserts that any combination of the Kimber and Bryant references does not teach or suggest the claim limitation of presently amended independent claim 1 calling for “selecting control settings for a printer using a control panel graphic user interface of said printer.” It is noted in the Office Action that “Kimber, however, fails to expressly disclose the use of a printer control panel to select the control settings.” Office Action mailed July 29, 2005, p. 4. Applicant asserts that Bryant does not teach or suggest selecting control settings with a graphic user interface. Bryant teaches or suggests a mechanical interface with an LCD display. *See*, FIG. 1 and Column 4 line 37 to Column 5 line 18. Applicant asserts that such is not a graphic user interface, or GUI, as the phrase is understood by one of ordinary skill in the art. Accordingly, Applicant asserts that neither Kimber nor Bryant nor any combination thereof teaches or suggests the claim limitation calling for “selecting control settings for a printer using a control panel graphic user interface of said printer.” Therefore, presently amended independent claim 1 is allowable.

Obviousness Rejection Based on Kimber in view of Bryant, and in further view of Chiles *et al.* (U.S. Patent 6,167,567)

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimber in view of Bryant, and in further view of Chiles *et al.* (U.S. Patent No. 6,167,567) (“Chiles”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 2 depends from presently amended independent claim 1. Applicant asserts that Chiles does not cure the failings of Kimber and Bryant regarding presently amended independent claim 1. Therefore, claim 2 is allowable as depending from allowable presently amended independent claim 1.

Obviousness Rejection Based on Kimber in view of Bryant, and in further view of Ueda (U.S. Patent 5,742,742)

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimber in view of Bryant, and in further view of Ueda (U.S. Patent 5,742,742). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 3 depends from presently amended independent claim 1. Applicant asserts that Ueda does not cure the failings of Kimber and Bryant regarding presently amended independent claim 1. Therefore, claim 3 is allowable as depending from presently amended independent claim 1.

Obviousness Rejection Based on Hibino in view of Kulakowski *et al.* (U.S. Patent 6,229,621)

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hibino in view of Kulakowski *et al.* (U.S. Patent 6,229,621) ("Kulakowski"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 6 depends from presently amended independent claim 4. Applicant asserts that Kulakowski does not cure the failings of Hibino regarding claim 4. Therefore, claim 6 is allowable as depending from allowable presently amended independent claim 4.

Obviousness Rejection Based on Hibino in view of Kimber

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hibino in view of Kimber. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 8 depends from presently amended independent claim 4. Applicant asserts that Kimber does not cure the failings of Hibino regarding presently amended independent claim 4. Therefore, claim 8 is allowable as depending from allowable presently amended independent claim 4.

Obviousness Rejection Based on Hibino in view of Chiles

Claims 10, 11, 16, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hibino in view of Chiles. Applicant respectfully traverses this rejection, as hereinafter set forth.

Claims 10 and 11 depend from presently amended independent claim 4. Applicant asserts that Chiles does not cure the failings of Hibino regarding presently amended independent claim 4. Therefore, claims 10 and 11 are allowable as depending from allowable presently amended independent claim 4.

Claims 16 and 20 depend from presently amended independent claim 12. Applicant asserts that Chiles does not cure the failings of Hibino regarding presently amended

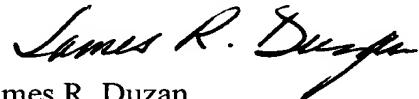
independent claim 12. Therefore, claims 16 and 20 are allowable as depending from presently amended independent claim 12.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Applicant submits that claims 1 through 20 are clearly allowable over the cited prior art.

Applicant requests the allowance of claims 1 through 20 and the case passed for issue.

Respectfully submitted,



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